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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,403	02/05/2004	Shinsuke Okada	P24588	3854

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RESTON, VA 20191		

EXAMINER	
KASZTEJNA, MATTHEW JOHN	

ART UNIT	PAPER NUMBER
3739	

NOTIFICATION DATE	DELIVERY MODE
06/12/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/771,403	Applicant(s) OKADA, SHINSUKE	
	Examiner Matthew J. Kasztejna	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 9, 2007 has been entered.

Notice of Amendment

In response to the amendment filed on March 7, 2007, amended claims 1 and 10 are acknowledged. The current rejections of the claims *are withdrawn*. The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the applicant considers to be the first and second lens units having first and second optical systems. As interpreted according to Figure 3 and paragraph 0035 of the applicant's specification, the objective lens system consists of a first objective lens system 810 and a second objective optical system 850. However, there is no disclosure of a first lens barrel in which a plurality of

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lens elements of the first optical system are assembled therein. Furthermore, there is no such disclosure of the first lens barrel being attached to a second lens barrel by a screw connection. Alternatively, if the claim is interpreted according to Figure 4 of the specification, the objective lens system consists of a first objective lens system 91 and a second objective optical system 95. However, the lens units are then aligned on a common optical axis as stated in paragraph 0053 of the specification, and not on first and second optical axes as claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,588,294 to Siegmund.

In regards to claims 1-2, Siegmund discloses an objective optical system configured to be implemented in a tip of an endoscope, comprising: a first lens unit having a first lens barrel and a first optical system 29 including a plurality of lens elements assembled in said first lens barrel and aligned in a direction of a first common optical axis; and a second lens unit having a second lens barrel, engaged to said first lens barrel, and a second optical system 34 including a plurality of lens elements aligned in a direction of a second common optical axis (see Fig. 5).

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,128,808 to Dosaka.

In regards to claims 1 and 10, Dosaka discloses an objective optical system comprising: a first lens unit 9a having a first lens barrel 9 and a first optical system 6 including a plurality of lens elements assembled in the first lens barrel aligned along a first optical axis; and a second lens unit 7a having a second lens barrel 7, engaged to the first lens barrel, and a second optical system 4 including a plurality of lens elements aligned a second optical axis (See Figs. 2 and 4).

In regards to claim 2, Dosaka discloses an objective optical system, wherein the first lens unit is provided with a fixing unit 20 that fixes the first optical system to the first lens barrel, the second lens barrel being assembled to the first lens barrel, the fixing unit being interposed between the first lens barrel and the second lens barrel to define a clearance therebetween (see Fig. 4).

In regards to claim 3, Plummer et al. discloses an objective optical system, wherein at least one of the first lens unit and second lens unit includes an alignment lens which is movable in a direction perpendicular to the optical axis thereof (see Col. 5, Lines 35-65).

In regards to claims 4-5, Dosaka discloses an objective optical system, wherein the alignment lens is included in the first optical system, the first lens barrel being formed with a plurality of holes through which parts of a circumferential surface of the alignment lens is seen and wherein the alignment lens is movably accommodated in the

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first lens barrel, the alignment lens being moved by pins inserted through the plurality of holes, respectively (see Figs. 7-8 and Col. 6, Lines 45-68).

In regards to claims 6-8, Dosaka discloses an objective optical system, wherein the alignment lens is configured to be most sensitive with respect to an alignment error among the plurality of lenses included in the first optical system (see Col. 6, Lines 45-68).

In regards to claims 9 and 11, Dosaka discloses an objective optical system, wherein the first lens barrel is attached to the second lens barrel by a screw connection (see Fig. 4 and Col. 5, Lines 35-65).

Response to Arguments

Applicant's arguments filed March 7, 2007 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation "configured to be implemented in a tip of an endoscope has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant states that the optical elements in each turret of Dosaka are not aligned in a direction of a common optical axis. However, the first and second lens units 9a and

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7a are fully capable of having various elements contained therein, contained on a single side of the turret (see Col. 4, Lines 23-51 and Figs. 4-7). Thus the optical elements would be arranged on a single optical axis with regard to each individual lens unit. As broadly as claimed, Dosaka meets the limitations of the recited claims.

Furthermore, applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK *ml*

6/1/7



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SUPERVISORY PATENT EXAMINER
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